



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/002,802	11/02/2001	Michael D. Uhler	UM-06669	3812

7590

03/21/2003

Jaen Andrews
MEDLEN & CARROLL, LLP
Suite 350
101 Howard Street
San Francisco, CA 94105

EXAMINER

NGUYEN, QUANG

ART UNIT PAPER NUMBER

1636

DATE MAILED: 03/21/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/002,802

Applicant(s)

UHLER, MICHAEL D.

Examiner

Quang Nguyen, Ph.D.

Art Unit

1636

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) ____ is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-42 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: _____

DETAILED ACTION

Claims 1-42 are pending in the present application.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group Restriction:

- I. Claims 1-13, 25-33 and 37-42, drawn to methods of transfecting a cell comprising contacting the cell with a transfection complex immobilized on a surface, wherein said complex comprising nucleic acid and first and second complexing agents, said first complexing agent comprising a ligand for a receptor, said second complexing agent comprising a DNA binding molecule, and the same transfection complex, classified in class 435, subclass 455.
- II. Claims 14-24, drawn to a method for immobilizing nucleic acid to a surface comprising combining said nucleic acid with first and second complexing agents, said first complexing agent comprising a ligand for a receptor, said second complexing agent comprising a DNA binding molecule, and contacting the transfection complex with a surface under conditions sufficient to immobilize said nucleic acid in said transfection complex, and an array comprising the same transfection complex immobilized on a surface, classified in class 436, subclass 518.

- III. Claims 34-36, drawn to a method of identifying a ligand of a receptor protein comprising contacting a cell with a transfection complex immobilized on a surface, said complex comprising first and second nucleic acids and first and second complexing agents, said first nucleic acid encoding a receptor and said second nucleic acid encoding a protein, wherein said first and second nucleic acid are present in at least one expression vector, and said first complexing agent comprising a ligand for a receptor, and said second complexing agent comprising a DNA binding molecule, and detecting the presence of a ligand-receptor binding pair, wherein the receptor protein is encoded by said first nucleic acid, classified in class 435, subclass 4.

The inventions are distinct, each from the other because of the following reasons:

The inventions of Groups I-III are distinct each from the others as they are drawn to methods having different starting materials, method steps, desired end-results and therefore they require different technical considerations for achieving the end-results. For examples, the invention in Group I is drawn to methods of transfecting a cell comprising contacting the cell with a transfection complex immobilized on a surface; the invention of Group II is simply directed to a method for immobilizing nucleic acid to a surface without requiring any cell or any contacting or transfecting step; the invention of Group III is drawn specifically to a method of identifying a ligand of a receptor protein involving different starting materials from those of the inventions of Groups I-II (e.g., the transfection complex comprises first and second nucleic acids wherein said first nucleic

Art Unit: 1636

acid encoding a receptor and said second nucleic acid encoding a protein, wherein said first and second nucleic acid are present in at least one expression vector. Additionally, the transfection complex of Group I is different chemically and structurally from an array article of Group II.

The several inventions above have acquired a separate status in the art as a separate subject for inventive effect and require independent searches. The search for each of the above inventions is not co-extensive particularly with regard to the literature search. Further, a reference which would anticipate the invention of one group would not necessarily anticipate or even make obvious another group.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, and separate search requirements (e.g., different classification), it would be unduly burdensome for the examiner to search and/or consider the patentability of all the inventions in a single application. Therefore, restriction for examination purposes as indicated is proper.

Species Restriction:

Should Applicants elect either Group I or II, claims 1-2, 8, 14-15, 21, 25-26 and 32 are generic to a plurality of disclosed distinct species comprising:

A specifically named additional complexing agent listed in the Markush group of claim 8, 21 or 32.

Applicant is required under 35 U.S.C. 121 to elect a specifically named species as indicated above.

Additionally, should Applicants elect Group I, claims 38-39 are generic to a plurality of disclosed distinct species comprising:

A specifically named viral protein listed in the Markush group of claim 39.

Applicant is required under 35 U.S.C. 121 to elect a specifically named species as indicated above.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over

Art Unit: 1636

the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quang Nguyen, Ph.D., whose telephone number is (703) 308-8339.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's mentor, Gerald Leffers, Jr., Ph.D., may be reached at (703) 305-6232, or SPE, Irem Yucel, Ph.D., at (703) 305-1998.

Quang Nguyen, Ph.D.

Gerald G. Leffers Jr.
PATENT EXAMINER
Gerald G. Leffers Jr.
A.U. 1636